

PTO Form 1960 (Rev 9/2007)

OMB No. xxxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76626479
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</p> <p>In re Application of: Riowell, LLC Serial No.: 76/626479 Filed: December 29, 2004 Mark: LEANLIFE</p> <p>Trademark Law Office No. 116 Examining Attorney: Susan Kastriner Lawrence</p> <p>- -</p> <p>BOX RESPONSES -- NO FEE Commissioner for Trademarks P.O. Box 1451 Alexandria, VA 22313-1451</p> <p><u>RESPONSE TO OFFICE ACTION EMAILED November 7, 2007</u></p> <p>Dear Examiner:</p> <p>This submission respectfully responds to the final office action mailed November 7, 2007.</p> <p><u>THE CURRENT OFFICE ACTION IS INCONSISTENT WITH THE PATENT AND TRADEMARK OFFICE'S PRIOR POSITION AND REGISTRATION OF THE CITED MARK</u></p> <p>Registration was refused for Applicant's LEANLIFE mark because, according to the Examiner, Applicant's mark so resembles the registered mark "LEAN FOR LIFE" as to be likely to cause confusion, to cause mistake, or to deceive. This refusal is inconsistent with</p>	

the position taken by the Office when it granted registration to the cited LEAN FOR LIFE mark.

On March 22, 1994, Applicant obtained registration of its LEANLIFE mark (U.S. Reg. No. 1,827,182). See LEAN LIFE Registration.pdf (attached). Applicant subsequently filed Section 8 and 15 affidavits, elevating its mark to incontestable status. Due to an inadvertent clerical error, Applicant's registration was accidentally cancelled on December 25, 2004. Realizing its error, on December 29, 2004 (four days after accidental cancellation), Applicant re-filed for registration of the LEANLIFE mark, resulting in the instant application (Serial No. 76/626,479). Applicant has continuously used its mark in commerce since December 10, 1992. The key fact, however, is that Applicant owned the registration to LEANLIFE in international class 005 for use in connection with "dietary food supplements of vitamins, minerals and herbs" from **March 22, 1994 through December 25, 2004**.

During that time, on December 13, 2002, Lindora, Inc. (owner of the cited mark, hereafter "Lindora") filed its application to register LEAN FOR LIFE in international classes 005, 029 and 030 (Serial No. 76/478,967, filed). In reviewing Lindora's application, the examiner performed two searches of the office records to identify potentially conflicting marks.

On March 11, 2003, the examiner conducted its first search. On March 24, 2003, the examiner issued an office action stating, among other things, "[t]he examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02." Lindora's Office Action.pdf (attached). At that time, the registration for Applicant's incontestable LEANLIFE mark was alive and well on the Principal Register (U.S. Reg. No. 1,827,182).

On August 25, 2004, the examiner conducted a second search of the office records to determine whether any conflicting marks existed. Again, at this time the registration for Applicant's incontestable LEANLIFE mark was alive and well on the Principal Register (U.S. Reg. No. 1,827,182). The examiner did not cite to Applicant's LEANLIFE mark, and shortly thereafter published and subsequently registered Lindora's LEAN FOR LIFE mark. Indeed, throughout the examination of Lindora's application, the examiner never even mentioned Applicant's existing registration for its incontestable LEANLIFE mark.

It is clear that the examiner did not feel there was a conflict between the marks at issue when it examined (not once but twice) and registered Lindora's mark. Indeed, if confusion were likely between the two marks, then Lindora's registration was granted improperly. On March 11, 2003 and again on August 25, 2004, the examiner reviewed Applicant's registered LEANLIFE mark and Lindora's mark and determined (twice) that the two marks could co-exist and that registration of Lindora's mark was proper. It is inequitable and inherently unfair that, under identical circumstances, Lindora's mark was allowed to register while Applicant's mark is refused. In light of this, Applicant respectfully requests that its LEANLIFE mark proceed to registration on the Principal register, as it had been since March 22, 1994,

If in the alternative, the examiner maintains the position that confusion is likely, Applicant has clear grounds to file for Cancellation of Lindora's registration, and respectfully requests that prosecution of the subject application be "suspended" pending resolution of the Cancellation Proceeding that Applicant will file. Applicant has first use in applications and registrations at issue. Thus, if the examiner deems registration of Applicant's mark improper, Applicant fully intends to file an immediate Cancellation proceeding against Lindora in light of

Applicant's prior use and registration. Therefore, if the examiner is inclined to overturn the precedent set by the prior examination of Lindora's application, Applicant requests that its application be suspended so that it may file a Cancellation proceeding with the TTAB.

Please contact me if you have any questions or concerns.

Respectfully submitted,
Rakesh M. Amin
Attorney for Applicant
Amin Hallihan,

LLC
444 N. Orleans Street, Suite 400

Chicago, IL 60610
Phone: (312) 327-3382
Fax: (312) 223-1515
trademark@aminhallihan.com

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/05/07/20080507183338434651-76626479-002_001/evi_7422254211-180119973_.LEANLIFE_Registration.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT\IMAGEOUT\766\264\76626479\xml1\RFR0002.JPG
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2008/05/07/20080507183338434651-76626479-002_002/evi_7422254211-180119973_.Lindora_s_Office_Action.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT\IMAGEOUT\766\264\76626479\xml1\RFR0003.JPG
	\\TICRS\EXPORT\IMAGEOUT\766\264\76626479\xml1\RFR0004.JPG
	\\TICRS\EXPORT\IMAGEOUT\766\264\76626479\xml1\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	"LEANLIFE Registration.pdf" is a copy of Applicant's registration which was "live" on the Principal Register when Lindora's LEAN FOR LIFE mark was granted registration. "Lindora's Office Action.pdf" is a copy of the office action issued by the Office in which the Examiner determined that there was no conflict between Applicant's mark and Lindora's mark.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Rakesh M. Amin/
SIGNATORY'S NAME	Rakesh M. Amin
SIGNATORY'S POSITION	Attorney
DATE SIGNED	05/07/2008
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed May 07 18:33:38 EDT 2008
TEAS STAMP	USPTO/RFR-74.222.54.211-2 0080507183338434651-76626 479-4205ed03843245e84b7eb 8a8615c3a4a8ab-N/A-N/A-20 080507180119973304

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **76626479** has been amended as follows:

ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Riowell, LLC
Serial No.: **76/626479**
Filed: **December 29, 2004**
Mark: **LEANLIFE**

Trademark Law Office No. 116
Examining Attorney: Susan Kastriner Lawrence

BOX RESPONSES -- NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION EMAILED November 7, 2007

Dear Examiner:

This submission respectfully responds to the final office action mailed November 7, 2007.

THE CURRENT OFFICE ACTION IS INCONSISTENT WITH THE PATENT AND TRADEMARK OFFICE'S PRIOR POSITION AND REGISTRATION OF THE CITED MARK

Registration was refused for Applicant's LEANLIFE mark because, according to the Examiner, Applicant's mark so resembles the registered mark "LEAN FOR LIFE" as to be likely to cause confusion, to cause mistake, or to deceive. This refusal is inconsistent with the position taken by the Office when it granted registration to the cited LEAN FOR LIFE mark.

On March 22, 1994, Applicant obtained registration of its LEANLIFE mark (U.S. Reg. No. 1,827,182). See LEAN LIFE Registration.pdf (attached). Applicant subsequently filed Section 8 and 15 affidavits, elevating its mark to incontestable status. Due to an inadvertent clerical error, Applicant's registration was accidentally cancelled on December 25, 2004. Realizing its error, on December 29, 2004 (four days after accidental cancellation), Applicant re-filed for registration of the LEANLIFE mark, resulting in the instant application (Serial No. 76/626,479). Applicant has continuously used its mark in commerce since December 10, 1992. The key fact, however, is that Applicant owned the registration to LEANLIFE in international class 005 for use in connection with "dietary food supplements of vitamins, minerals and herbs" from **March 22, 1994 through December 25, 2004**.

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LEANLIFE mark and Lindora's mark and determined (twice) that the two marks could co-exist and that registration of Lindora's mark was proper. It is inequitable and inherently unfair that, under identical circumstances, Lindora's mark was allowed to register while Applicant's mark is refused. In light of this, Applicant respectfully requests that its LEANLIFE mark proceed to registration on the Principal register, as it had been since March 22, 1994,

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Please contact me if you have any questions or concerns.

Respectfully submitted,
Rakesh M. Amin
Attorney for Applicant
Amin Hallihan,

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Fax: (312) 223-1515
trademark@aminhallihan.com

EVIDENCE

Evidence in the nature of "LEANLIFE Registration.pdf" is a copy of Applicant's registration which was "live" on the Principal Register when Lindora's LEAN FOR LIFE mark was granted registration.

"Lindora's Office Action.pdf" is a copy of the office action issued by the Office in which the Examiner determined that there was no conflict between Applicant's mark and Lindora's mark. has been attached.

Original PDF file:

http://tgate/PDF/RFR/2008/05/07/20080507183338434651-76626479-002_001/evi_7422254211-180119973_LEANLIFE_Registration.pdf

Converted PDF file(s) (1 page)

Evidence-1

Original PDF file:

http://tgate/PDF/RFR/2008/05/07/20080507183338434651-76626479-002_002/evi_7422254211-180119973_Lindora's_Office_Action.pdf

Converted PDF file(s) (3 pages)

Evidence-1

Evidence-2

Evidence-3

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Rakesh M. Amin/ Date: 05/07/2008

Signatory's Name: Rakesh M. Amin
Signatory's Position: Attorney

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76626479
Internet Transmission Date: Wed May 07 18:33:38 EDT 2008
TEAS Stamp: USPTO/RFR-74.222.54.211-2008050718333843
4651-76626479-4205ed03843245e84b7eb8a861
5c3a4a8ab-N/A-N/A-20080507180119973304

Int. Cl.: 5

Prior U.S. Cl.: 18

United States Patent and Trademark Office

Reg. No. 1,827,182

Registered Mar. 22, 1994

**TRADEMARK
PRINCIPAL REGISTER**

LEANLIFE

**NUTRITION FOR LIFE INTERNATIONAL
(PARTNERSHIP)
8801 JAMEEL
HOUSTON, TX 77040**

**FIRST USE 12-10-1992; IN COMMERCE
12-10-1992.**

SER. NO. 74-401,158, FILED 6-14-1993.

**FOR: DIETARY FOOD SUPPLEMENTS OF
VITAMINS, MINERALS AND HERBS, IN
CLASS 5 (U.S. CL. 18).**

**HOWARD B. LEVINE, EXAMINING ATTOR-
NEY**

To: LINDORA, INC. (jill@gehringcurb.com)
Subject: TRADEMARK APPLICATION NO. 76478967 - LEAN FOR LIFE -
Sent: 3/24/03 10:13:13 AM
Sent As: ECom105
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/478967

APPLICANT: LINDORA, INC.

CORRESPONDENT ADDRESS:

JILL CURB
GEHRING & CURB
12100 WILSHIRE BOULEVARD
SUITE 1900
LOS ANGELES CALIFORNIA 90025

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom105@uspto.gov

MARK: LEAN FOR LIFE

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

jill@gehringcurb.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 76/478967

The assigned examining attorney has reviewed the referenced application and determined the following.

NO CONFLICTING MARKS:

The examining attorney has searched the Office records and has found no similar registered or pending mark which would

bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

IDENTIFICATION OF GOODS AND CLASSIFICATION:

The identification of goods is unacceptable as indefinite because the wording is vague and overly broad and may fall in an additional class. The applicant may adopt the following identification, if accurate:

Dietetic substances, namely, multi-vitamins, ketosis sticks for determining fat burning status; and meal replacement powder drink in various flavors to be used in connection with medical clinics oriented to weight management and weight loss, in International Class 5.

Meal replacement, namely, chocolate drink in the nature of _____ (the applicant must specify item, for instance, dairy-based chocolate food beverages; snack, namely, _____ (the applicant must specify item, for instance, strawberry-based snack food), in International Class 29.

Meal replacement, namely, hot chocolate and pudding mixes in various flavors to be used in connection with medical clinics oriented to weight management and weight loss, in International Class 30.

TMEP §1402.01.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

The decision as to the proper classification of goods or services is a purely administrative matter which is within the sole discretion of the Patent and Trademark Office. *In re Tee#Pak, Inc.*, 164 USPQ 88 (TTAB 1969).

REQUIREMENTS FOR COMBINED APPLICATION:

If the applicant prosecutes this application as a combined, or multiple#class, application based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), the applicant must comply with each of the following:

- (1) The applicant must specifically identify the goods in each class and list the goods by international class with the classes listed in ascending numerical order. TMEP §1403.01.
- (2) The applicant must submit a filing fee for each international class of goods/services not covered by the fee already paid. 37 C.F.R. §§2.6(a)(1) and 2.86(b); TMEP §§810.01 and 1403.01. Effective January 1, 2003, the fee for filing a trademark application is \$335 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.
- (3) The applicant must submit:
 - (a) dates of first use and first use in commerce and one specimen for each class that includes goods or services based on use in commerce under Trademark Act Section 1(a). The dates of use must be at least as early as the filing date of this application, 37 C.F.R. §§2.34(a)(1) and 2.86(a), and the specimen(s) must have been in use in commerce at least as early as the filing date of the application, and/or

(b) a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class that includes goods or services based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), where such statement was not included for the goods or services in the original application.

- (4) The applicant must submit an affidavit or a declaration under 37 C.F.R. §2.20 signed by the applicant to verify (3) above. 37 C.F.R. §§2.59(a) and 2.71(c).

RESPONSE:

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Marlene Bell/

Marlene D. Bell

Examining Attorney

LO 105

(703) 308-9105 X 173

ecom105@uspto.gov<<mailto:ecom105@uspto.gov>>

marlene.bell@uspto.gov

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>